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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,819	01/24/2006	Warner R. T. Ten Kate	NL030922	7300

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EXAMINER

HUQ, FARZANA B

ART UNIT	PAPER NUMBER
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2155

MAIL DATE	DELIVERY MODE
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04/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/565,819	TEN KATE ET AL.	
	Examiner	Art Unit	
	FARZANA HUQ	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/24/2006 and 8/30/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application filed on January 24, 2006. Claims 1-20 are directed towards Dvd-linked internet bookmarking. Claims 1-20 are pending.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: **computer program product** is not defined in the specification with further detail for one in the ordinary skill in the art to understand what computer program product represents.

Claim Objections

3. Claim 1 is objected to because of the following informalities: “**hereinafter referred to as "server content"'**” and “**hereinafter referred to as "local content"'**”. Examiner suggests applicant to keep it consistent with other independent claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. It is important to note that independent claims 1 and 19, dependent claims 2~17, are replete with intended use recitations. The claim does not require anything new in that the limitations are "configured to", "according to", "operable to", etc. perform steps that practically any computer can be configured to perform. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in

order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Applicant failed to specifically point out any further contentions and thus failed to claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

5. Claim 20 is rejected under 35 U.S.C. 101 because the claim invention is directed to non-statutory subject matter. According to the specification of the invention **"a computer program"** is reasonably interpreted by one of ordinary skill as just software, it is a system of

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software, per se. In this claim the function of the program is just software not any hardware. Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. Similarly, computer readable medium claimed as computer instructions per se, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions. So, it does not appear that a claim reciting computer instructions with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-8, 10-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Gewickey et al. hereinafter Gewickey (U.S. Publication 2005/0041150).

Gewickey teaches the invention as claimed including providing content-owner control in a networked device (see abstract).

7. As per claim 1, Gewickey discloses a system including a rendering apparatus, a server and a network for communication between the rendering apparatus and the server (figure 1-5); the server having access to content, hereinafter referred to as "server content"; separately accessible items of the server content being identified by respective server content locators, such as a URL (figure 2, and 9, paragraphs [0009, 0035-0037, 0042, 0043, 0055, 0102], Gewickey discloses links from the dvd disc is able to connect to the server to retrieve contents); the rendering apparatus having access to further content, hereinafter referred to as "local content"; titles of the local content being associated with respective local content identifiers; the rendering apparatus being operative to render items of the local content and to render server content items that relate to the local content items (paragraphs [0009, 0029, 0046, 0055-0057, 0083, 0139], discloses local identifying local content by its title or other identifiers); the system being operative to generate and to store a plurality of bookmarks identifying respective server content items; each bookmark including a server content locator and a local content identifier (paragraphs [0043, 0044, 0050, 0140], discloses storing of bookmarks which includes locators and local identifier); and the rendering apparatus being operative to render a server content item indicated by the server content locator of a bookmark conditional on having access to a local

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content title associated with the local content identifier of the bookmark (figure 7, paragraphs [0043, 0046, 0047, 0050, 0117-0119], Gewickey server content is located by URL accessed from dvd disc).

8. As per claim 2, Gewickey discloses a system wherein the rendering apparatus includes a user interface for presenting to a user which stored bookmarks are selectable for rendering of server content indicated by the respective bookmark (figure 2, paragraphs [0042-0044]).

9. As per claim 3, Gewickey discloses a system wherein a bookmark is selectable only if the rendering apparatus has access to a local content title associated with the local content identifier of the bookmark (paragraphs [0034-0038, 0042-0047]).

10. As per claim 4, Gewickey discloses a system wherein the rendering apparatus includes a user interface for presenting bookmarks to a user organized according to the respective local content identifiers of the bookmarks (paragraphs [0049, 0050, 0083]).

11. As per claim 5, Gewickey discloses a system wherein the rendering apparatus is operative to render a server content item indicated by the server content locator of a bookmark synchronous to rendering the local content title associated with the local content identifier of the bookmark (paragraphs [0043-0047, 0050, 0054, 0083]).

12. As per claim 6, Gewickey discloses a system wherein separately accessible items of the local content are identified by respective local content locators, such as a time indicator; the bookmark including a local content locator enabling starting the rendering of the local content title at a location indicated by the local content locator (paragraphs [0051, 0053, 0083]).

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13. As per claim 7, Gewickey discloses a system wherein the bookmark includes a user ID identifying a user of the rendering apparatus, and/or a family ID identifying a family of users of the rendering apparatus (figure 4 and 9, paragraphs [0046, 0047]).

14. As per claim 8, Gewickey discloses a system wherein the user interface is operative to present the stored bookmarks organized according to the user ID and/or family ID of the bookmarks (figure 4 and 9, paragraphs [0046, 0047]).

15. As per claim 10, Gewickey discloses a system wherein the system is operative to generate and store a bookmark in response to an instruction from a user, where the generated bookmarks includes a server content locator identifying a server content item currently being rendered and a local content identifier associated with a local content item that currently is accessible (paragraphs [0043, 0044, 0050, 0140]).

16. As per claim 11, Gewickey discloses a system wherein the system is operative to generate bookmarks automatically (paragraphs [0065, 0066, 0102, 0106]).

17. As per claim 12, Gewickey discloses a system wherein the system is operative to generate a bookmark for a server content item in response to an instruction to terminate rendering of a server content item to enable resumption of rendering of the server content item (paragraphs [0114, 0115, 0117, 0118]).

18. As per claim 13, Gewickey discloses a system wherein the system is operative to generate a bookmark for a server content item in response to a user selecting a server content item for rendering, creating a history list of bookmarks (paragraphs [0059, 0077, 0111, 0114]).

19. As per claim 14, Gewickey discloses a system wherein the rendering apparatus is operative to verify an authenticity of an accessible local content title and to render a server

content item indicated by the server content locator of a bookmark only upon a positive outcome of the verification (paragraphs [0053, 0057, 0070-0073, 0134, 0135]).

20. As per claim 15, Gewickey discloses a system wherein a local content title is stored on a removable storage medium including a medium identifier; the local content identifier including the medium identifier (paragraphs [0046, 0047, 0052, 0056, 0057]).

21. As per claim 16, Gewickey discloses a system the rendering apparatus being operative to generate the bookmarks (paragraphs [0043, 0050, 0102]).

22. As per claim 17, Gewickey discloses a system the server being operative to store the bookmarks (paragraphs [0029, 0036, 0059]).

23. As per claim 18, Gewickey discloses a method of generating a bookmark to content in a server accessible through a network; the method including: retrieving a local content identifier associated with a title of content accessible for rendering by a rendering apparatus local to the content (paragraphs [0009, 0029, 0046, 0055-0057, 0083, 0139], discloses local identifying local content by its title or other identifiers); retrieving a server content locator, such as a URL, identifying a separately accessible item of the server content that is related to the local content title (figure 2, and 9, paragraphs [0009, 0035-0037, 0042, 0043, 0055, 0102], Gewickey discloses links from the dvd disc is able to connect to the server to retrieve contents); and generating and storing a bookmark that includes the server content locator and the local content identifier (paragraphs [0043, 0044, 0050, 0140], discloses storing of bookmarks which includes locators and local identifier).

24. As per claim 19, Gewickey discloses a method of accessing content in a server accessible through a network; the method including: retrieving a bookmark that includes: a local content

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identifier associated with a title of content accessible for rendering by a rendering apparatus local to the content (paragraphs [0009, 0029, 0046, 0055-0057, 0083, 0139]); and a server content locator, such as a URL, identifying a separately accessible item of the server content that is related to the local content title (figure 2, and 9, paragraphs [0009, 0035-0037, 0042, 0043, 0055, 0102]); and rendering a server content item indicated by the server content locator of the bookmark conditional on having access to the local content title associated with the local content identifier of the bookmark (paragraphs [0043, 0044, 0050, 0140]).

25. As per claim 20, Gewickey discloses a computer program product operative to cause a processor to perform the method (figure 1, paragraphs [0034, 0056, 0068]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

26. Claim 9 is rejected under 35 U.S.C. 102(e) as being unpatentable over Gewickey et al. hereinafter Gewickey (U.S. Publication 2005/0041150) in view of Glenn Evans hereinafter Evans (U.S. Patent 7200323).

Gewickey teaches the invention substantially as claimed including providing content-owner control in a networked device (see abstract).

27. As per claim 9, Gewickey discloses a system wherein the rendering apparatus being operative to present a bookmark and/or to render a remote item indicated by a bookmark only if indicator of the bookmark matches a setting of the rendering apparatus (paragraphs [0072, 0073]).

Although Gewickey discloses preventing access to content which requires parental monitoring, he does not explicitly disclose the bookmark includes a parental level indicator, and/or to render a remote item indicated by a bookmark only if the parental level indicator of the bookmark matches a parental level setting of the rendering apparatus.

However, in the same field of endeavor Evans discloses the bookmark includes a parental level indicator, and/or to render a remote item indicated by a bookmark only if the parental level indicator of the bookmark matches a parental level setting of the rendering apparatus (col. 2 lines 5-26, col. 3 lines 23-38, col. 6 lines 36 - col. 7 lines 5).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of invention was made to have incorporated Gewickey's teaching with the teaching of Evans. One would be motivated to implement parental control indicator to identify if a particular content is restricted for viewing for restricting unwanted or harmful information. If the parental level matches with the indicated set level, only then content are legitimate for viewing.

Conclusion

28. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kanada et al. (U.S. Publication 20040006607) discloses content data providing server, content data providing system and method, and terminal unit.
- Flynn et al. (U.S. Patent 7162476) discloses system and method for sharing global data within distributed computing systems.
- Lamkin et al. (U. S. Patent 7178106) discloses presentation of media content from multiple media sources.
- Getsin et al. (U. S. Patent 7269634) discloses system, method and article of manufacture for remote control and navigation of local content.

- Lamkin et al. (U.S. Patent 7346920) discloses system, method and article of manufacture for a common cross platform framework for development of DVD-video content integrated with ROM content.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FARZANA HUQ whose telephone number is (571)270-3223. The examiner can normally be reached on Monday - Friday: 7:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Farzana Huq/
Examiner, Art Unit 2155

/saleh najjar/
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